

### **REMARKS**

Applicant acknowledges with appreciation the personal interview between Applicant's Representative and Examiner Pham on January 10, 2008. The substance of the interview is discussed below.

As discussed at the interview, the claims have been amended to streamline prosecution. Seven independent claims have been canceled (27, 36, 42, 44, 46, 47, 49 and 50) and one independent claim (16) has been amended to be dependent upon claim 1, while only three independent claims have been added, for a total reduction of six independent claims. Applicant reserves the right to file one or more continuation applications claiming subject matter in the canceled claims as well as other disclosed subject matter.

The September 14, 2007 Office Action rejected all then pending claims under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,839,707 ("Lee et al."). The rejections are traversed, and reconsideration is respectfully requested in view of the following.

#### **Claim 1**

Claim 1 claims a system for providing legal information comprising associated items of legal information and content. The system comprises at least one computer and a plurality of user terminals which communicate over a network, and at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information.

The legal information comprises items of information with each of which is associated content, and the legal information is stored in association with legal topics and type of legal information. As argued at the interview, such characteristics of the legal information and the manner in which the legal information is stored in the database, i.e., in association with topics and types, are claim limitations that must be given patentable weight.

Claim 1 also claims a computer readable medium or media storing programming that causes the at least one computer to perform the recited functionality, namely: to access within the at least one database legal information related to at least one legal topic responsive to a request received from a user terminal, and to cause each item of legal information associated with the accessed information to be provided for display on a display device associated with the user terminal from which the request was received, *tabulated by type of legal information*.

*Lee et al. vs. the application*

This application discloses systems, methods, and computer programs for fulfilling requests from users wanting current information related to legal or other topics designated by the users from lists of available topics, where the information related to available topics is classified by type. (Abstract) Such systems, methods and computer programs provide information to users and automated current awareness services particularly in the legal field. (¶ [0005]) According to the application, various types of legal information may be provided, including court decisions, codifications of statutes, rules, and the like, and other legal, business, professional, and/or news information. (See, e.g., Figs. 4 & 10 and ¶ [0035]) The provided information is sometimes referred to as current awareness information, for example where it is provided on an automatically-updated basis, and can include both traditional news types, including, for example, newly-issued or released judicial decisions, recently filed court documents, announcements of administrative decisions or legislative actions, new statutes and administrative rules, newspaper or magazine articles related to legal topics, etc. (¶ [0012]) For example, by entering a suitable request or command, a user may request information relating to judicial decisions, legislative actions, and/or other types or items which is displayed in the form of document titles or summaries. (¶ [0015])

In paragraph [00004], the application refers to two widely used other legal research systems, namely the *Westlaw* legal research system of The Thomson Corp. and the *LexisNexis* legal research system of Reed Elsevier Inc.

Lee et al. on the other hand discusses a legal management system (LMS), describing it as “a fully integrated on-line web-based company-wide communication tool.” (Col. 1, lines 31–32.) The LMS, according to Lee et al., is a centralized and integrated legal department management tool. (Col. 1, lines 32–35.) In other words, the LMS is a knowledge or document management system (see col. 1, lines 15-25 and col. 2, lines 23-24) that indexes documents internal to an organization, including model and sample agreements, research memos, and guidelines (col. 7, lines 5–9).

Perhaps the following from Lee et al. illustrates what the Lee et al. system is:

The system captures business/legal information pertaining to the business entity and provides such information in a variety of reporting formats on-line to the user. In one exemplary embodiment, the system utilizes a Structured Query Language (SQL) server database with a client user interface front-end for administration and a web interface for standard user input and reports. The LMS stores business/legal department related data in the database in several separate sections such as a Practice Group Information Section, a Preferred Provider Information Section, a Regional Information Section, a Commercial Transaction Information Section, an Organizational Information Section, an Administrative/Security Information Section, and a Resources Information Section. (Col. 1, line 60 to col. 2, line 7.)

Thus, the systems disclosed by Lee et al. and the application are fundamentally different, just as Lee et al. is fundamentally different from the legal research systems referred to by the Applicant in paragraph [0004] of the application (*Westlaw* and *LexisNexis*) and the legal research system that the Examiner referred to at the interview - the *United States Patent Quarterly* (“USPQ”), which reports judicial and USPTO decisions relating to patents, among other intellectual property areas of law, and is provided by BNA (The Bureau of National Affairs, Inc.)

**Claim 1 and “tabulated by type of legal information”**

As discussed at the interview, providing items of information for display “tabulated by type of legal information” is a claim limitation that must be interpreted in context with the specification, and with that interpretation given patentable weight. At the interview, Applicant’s Representative understood the Examiner to take the position that “type of legal information” can be just about any displayed text item in Figs. 6-17 of Lee et al. The interview concluded with no agreement on this point, which is discussed in greater depth below.

As pointed out above and argued at the interview, the term “type” must be interpreted in context with the specification. Applicant’s specification consistently and extensively discusses “type” in context. Please refer to the quoted passages below which appear in the identified paragraph number before the quoted passage.

[0008] For example, where information related to a legal topic such as "securities" or "corporate" law is requested, and the responsive information is classified into types, including for example judicial decisions, statutes, administrative rules, and administrative decisions, a separate window is presented for each classification: one for judicial decisions, one for statutes, etc.

[0012] Provided information, sometimes also referred to as current awareness information, for example where it is provided on an automatically-updated basis, can include both traditional news types, including, for example, newly-issued or released judicial decisions, recently filed court documents, announcements of administrative decisions or legislative actions, new statutes and administrative rules, newspaper or magazine articles related to legal topics, etc.;

[0015] For example, in a system in which information relating to a number of judicial decisions, legislative actions, and/or other types or items

[0021] In systems according to the invention adapted for the provision of legal information, classifications of information relating to individual topics can be made, for example, by sorting information into classes or types such as administrative action, legislative action, rulemaking, reported judicial decisions, and news.

[0042] For example, in a system for providing legal information using the topic list set out above, the types or classes "administrative action," "current rulemaking," "news," "recent cases," and "legislative alert" have been found to be widely applicable.

[0074] The securities law monitor display which results comprises a plurality of windows 401-405, each dedicated to the display of a separate type or class of information available for the topic "securities."

[0076] Window 401 of FIG. 4 displays information items relating to the class or type "administrative action", which includes news items, administrative orders, and other items relating to administrative action in the securities law topic. Window 402 displays items relating to the type "current rulemaking" in the securities law topic, including for example rule change proposals published by the Securities Exchange Commission (SEC) and the National Association of Stock Dealers (NASD), etc., and recent relevant publications in the Federal Register. Window 403 displays items associated with the type "securities news" pertaining to news in the securities and securities law topic area, including for example articles gathered from primary and secondary news sources. Window 404 displays items of the type "recent cases" pertaining to recent judicial decisions published in the securities law topic, including for example relevant decisions of the United States and state courts, as well as reports of newly-filed cases and developments in ongoing cases. Recently updated court docket reports are also available, along with other suitable data items.

Please also refer to Fig. 4 of the application, where items of information 460 appear in separate windows 401-405 tabulated by type "Administrative Action" (window 401), "Current Following" (window 402), etc.

Although the words of the claim are to be given their “broadest reasonable interpretation,” the MPEP repeatedly cautions that this interpretation must also be consistent with the specification. *See* MPEP § 2111 (8th ed. [R-5] 2006), and the passages quoted below (with emphasis supplied).

During patent examination, the pending claims must be "given their broadest reasonable interpretation ***consistent with the specification.***"

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "***in light of the specification as it would be interpreted by one of ordinary skill in the art.***"

Although claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms ***reasonably*** allow. In re American Academy of Science Tech Center, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation ***in light of the specification.***).

Thus, if a claim term is given meaning in the specification, the claim term must be interpreted consistent with the meaning given in the specification. Interpreting a claim term in this manner is not the same as importing into the claim a limitation from the specification. As the MPEP commented, quoting from a court opinion:

"reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim."

It is respectfully submitted that the Examiner does not have the latitude to give a term in a claim an interpretation that is inconsistent with the specification, or otherwise unreasonable, which it is submitted the Examiner has done in equating the term “type of legal information” with just about any item displayed in Figs. 6-17 of Lee et al.

In the September 14, 2007 Office Action, the Examiner (i) refers to Fig. 7 of Lee et al. as disclosing “at least one database...for storing...at least one type of legal information of a plurality of types of legal information” (bottom of page 2 to top of page 3 of Office Action), and (ii) simply to Figs. 6-17 as a disclosure of the claim limitation “cause the accessed information to be displayed on a display device associated with the terminal from which the request was received, tabulated by type of legal information.” The Examiner made no attempt to identify what in Fig. 7 or Figs. 6-17 allegedly discloses “tabulated by type of legal information.” The Office Action does not refer to any text in Lee et al. that may be relevant to this limitation in claim 1. At the interview, the Examiner was no more specific and was understood by Applicant’s Representative to be saying that just about anything in Figs. 6-17 can be interpreted to by a type of legal information.

However, it is clear by comparing Figs. 6-17 of Lee et al. to Fig. 4 of the application that items “tabulated by type of legal information” in Fig. 4 of the application are no where to be seen in Figs. 6-17 of Lee et al., unless, of course, “type of legal information” can have any meaning the Examiner wants to give it, which would be contrary to the MPEP which cautions that interpretation of a claim term must not be unreasonably broad as to be inconsistent with the specification. Figs. 6-17 of Lee et al. are discussed below with this in mind.

Cited Figs. 6-17 in Lee et al. appear to depict various windows that a computer might present on a display when a Web browser is used to access a corporate intranet. The windows comprise various items, controls, or both, some of which are arranged under headings. It is respectfully submitted that, given any reasonable interpretation of the claim terms, the depicted windows fail to disclose or suggest tabulating information by type of legal information, within the meaning of claim 1.

For example, Fig. 6 of Lee et al. depicts a display with entries under the headings “Practice Groups,” “Regional Components,” “Our Organization,” “Technology,” “Human Resources” and “Quality.” These simply are not “types of legal information” as claimed in claim 1. There is no disclosure in Lee et al. that information in the items under “Practice Groups,” namely, “Antitrust,” “Consumer Law & Policy,” “E-Commerce & Information Technology,”...and “Tax” all relate to the same type of legal information. Right on the face of Fig. 6, it can be seen that these items are not types of legal information and that there is no display of legal information tabulated by type, as claimed in claim 1. The same applies to the items under the other headings in Fig. 6.

Fig. 7 of Lee et al. depicts a display with entries under the headings: “Quality Initiatives,” “Preferred Providers,” “Practice Areas,” “Document Library,” “Communications,” and “Links.” Again, these headings are simply not “types of legal information” as claimed in claim 1.

Fig. 8 of Lee et al. depicts a display with entries under the headings: “Communications,” “Environmental,” “Labor & Employment,” “Litigation & Compliance,” “Commercial Transactions,” and “Tax.” (Nothing appears under the headings “Antitrust,” “Government Business” and “Intellectual Property.”) Once again, these headings are simply not “types of legal information” as claimed in claim 1.

The same applies more or less to Figs. 9-13. The display screen depicted in Fig. 14 does not show headings.

Fig. 16 depicts Library Headings. There is no disclosure in Lee et al. that information in any items navigated to by selecting one of the libraries would contain the same type of legal information. In contrast, please see Fig. 4 of the application where, under “Recent Cases,” for example, all of the displayed items relate to cases, and under “Administrative Action,” all of the displayed items relate to administrative actions.



Therefore, when an interpretation of “tabulated by type of legal information” is given an interpretation in context with the application, then Lee et al. does not disclose the following limitation in claim 1:

computer readable medium or media storing programming that causes the at least one computer to:...cause each item of legal information associated with the accessed information to be provided for display... *tabulated by type of legal information*. (Emphasis supplied.)

However, as discussed below, claim 1 includes other limitations not disclosed in Lee et al.

**Claim 1 and the “at least one database... storing the legal information in association with a plurality of legal topics and a plurality of types of legal information”**

In addition to a computer readable medium or media storing programming that causes the at least one computer to cause each item of legal information associated with accessed information to be provided for display tabulated by type of legal information, claim 1 also claims at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information. Thus, another limitation in claim 1 is a database in which legal information is stored in association with topics and type of legal information. This facilitates the at least one computer causing each item of legal information associated with accessed information to be provided for display tabulated by type of legal information.

Lee et al. does not disclose:

at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information.

In connection with this element, as pointed out above, the Examiner refers (i) to Figs. 3, 6 and 7 as disclosing “at least one database...for storing information related to a plurality of legal topics...and to least one type of legal information of a plurality of types of legal information,” and (ii) to Figs. 10-11 for a disclosure of “the information being stored in relation to the plurality

of legal topics. (Bottom of page 2 to top of page 3 of Office Action.) However, the Examiner makes no specific reference as to what in any of Figs. 3, 6, 7, 10 or 11, or any text in Lee et al., that is an alleged disclosure of this element. With respect to accessing a database, the Examiner makes reference to col. 2, lines 14–22 and Fig. 6 of Lee et al. (top of page 3 of the Office Action). But the cited portion discusses only certain actions involving a database and “legal/business information.” It discloses neither the existence of even a single legal topic nor storage of information in relation to such a topic or topics. In fact, Lee et al. nowhere discloses either element.

For the foregoing reasons, Applicant respectfully submits that Lee et al. fails to disclose the invention claimed in claim 1, and that claim 1 is allowable over Lee et al. Because claim 1 was demonstrated to be allowable for at least the reasons presented above, in the interests of brevity, this Response does not discuss each and every comment directed to Lee et al. in the September 14, 2007 Office Action. This should not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments.

**Claims dependent upon claim 1**

Claims 2-11, 16-17, 56-57 and 18-24 are dependent upon claim 1 directly or through another dependent claim. These dependent claims should be allowed based at least on their inclusion of subject matter deemed to be allowable for the reasons discussed above. While specific arguments for the patentability of the inventions defined by these dependent claims are not presented herein, Applicant reserves the right to present these arguments in this or a subsequent proceeding. Also, because claim 1 was demonstrated to be allowable for at least the reasons presented above, in the interests of brevity, this Response does not discuss each and every comment in the September 14, 2007 Office Action directed to Lee et al. and these dependent claims. This too should not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments.

**Independent claims 58 and 68 & dependent claims 59-67**

New independent claims 58 and 68 are directed to a method and computer program product, respectively, that include limitations similar to those already discussed in connection with claim 1, but in the context of a method and computer program product, respectively. Therefore, it is submitted that independent claim 58 (and claims 59-67 which are dependent upon claim 58) and independent claim 68 are allowable over Lee et al. Here too, Applicant reserves the right to make specific arguments for the patentability of these claims should the need to so do arise.

**Independent claims 30 & 69, and dependent claims 32-35**

Claim 30 claims a method of processing legal information, comprising assigning at least one identifier to each of a plurality of documents comprising legal information relating to a plurality of legal topics. The at least one identifier is claimed as being associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information. The method also comprises:

- formatting the documents according to a protocol;
- storing the formatted documents in at least one database;
- using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics; and
- causing legal information associated with the identified documents to be provided for display on the display device tabulated by type.

In the rejection of claim 30 (page 11 of Office Action), the Examiner cites to Lee et al. at: col. 10, lines 34-44, Figs. 6, 12; col. 9, line 10; col. 10, lines 44-65; and col. 10, lines 65-67 and Fig. 7. These passages of Lee et al. are discussed below.

Col. 10, lines 34-44 of Lee et al. refers to the user adding, updating or deleting documents in Lee et al.'s LMS as described generally in the previous paragraph (col. 10, line 23-34). Specifically, col. 10, lines 34-44 refer to adding a file from the user's hard drive, or a link to Lee

et al.'s LMS. This passage does not disclose assigning at least one identifier to each of a plurality of documents comprising legal information relating to a plurality of legal topics, where the at least one identifier is associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information, as claimed in claim 30. This cited passage from Lee et al. also does not disclose formatting the received documents according to a protocol, storing the formatted documents in at least one database, using assigned identifiers to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics, as claimed in claim 30. This cited passage also does not disclose causing legal information associated with the identified documents to be provided for display on the display device tabulated by type, as claimed in claim 30.

Col. 10, lines 44-65 of Lee et al. refer to the search screen of Fig. 14 for conducting “various types of searches based on Boolean type 692, Concept type 694 or Pattern type 696. The user can type a word or a phrase in a box 698, select a type of search 700, select a library 702, select a section of the library 704, and select a search button 710.” The Examiner has not identified what in the cited passage or in Figs. 6, 12 or 14 (or anywhere else in Lee et al.) relates to an identifier which is associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information, as claimed in claim 30. (Please refer to the comments above regarding “types of legal information”).

Col. 9, line 10 of Lee et al. refers to Content Management user interface 480, which Lee et al. mentions is also known as a home page of content management, and which is organized into logical groups 488. The relevance of this cited passage to claim 30 is not understood by Applicant's Representative.

Col. 10, lines 65-67 of Lee et al. state “The results of the search are displayed on the user interface with hypertext links to direct the user to the specific request.” From this one might infer that the Examiner contends that the hypertext links are the identifiers recited in claim 30. But the hypertext link is simply a link to a document and does not suggest any of the organization defined in claim 30, e.g., legal information relating to a plurality of legal topics, and at least one

identifier that is associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information. In Lee et al., the link simply points to a document.

For the reasons discussed above, it is submitted that claim 30 is allowable over Lee et al. In addition, claim 30 claims assigning to each of a plurality of documents, which each comprises legal information relating to a plurality of legal topics, at least one identifier associated with at least one of a plurality of types of legal information, and using the identifier to access legal information. As discussed extensively above in connection with claim 1, Lee et al. does not disclose organizing or displaying legal information by type. For this reason as well, it is submitted that claim 30 is allowable over Lee et al.

New independent claim 69 is directed to a computer program product that includes limitations similar to those already discussed in connection with claim 30, but in the context of a computer program product. Therefore, it is submitted that independent claim 69 is allowable over Lee et al.

Claims 32-35 are dependent upon claim 30 directly or through another dependent claim. These claims should be allowed based at least on their inclusion of subject matter deemed to be allowable for the reasons discussed above. While specific arguments for the patentability of the inventions defined by these dependent claims are not presented herein, Applicant reserves the right to present these arguments in this or a subsequent proceeding. Also, because claim 30 was demonstrated to be allowable for at least the reasons presented above, in the interests of brevity, this Response does not discuss each and every comment in the September 14, 2007 Office Action directed to Lee et al. and these dependent claims. This too should not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments.

**Closing**

It is submitted that application is in allowable condition. Reconsideration and allowance of the application with claims 1-12, 16-24, 30, 32-35 and 56-69 are respectfully requested.

The Examiner is respectfully invited to contact Applicant's Representative by telephone on any issue which the Examiner believes is suitable for possible resolution or clarification by telephone.

Respectfully submitted,



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Date: March 10, 2008

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